

Appln. No. 10/706,425
Filing Date: November 12, 2003
Amendment filed November 5, 2008
Reply to Office action mailed August 6, 2008

REMARKS

Claims 22-55 are pending in the Application and all were rejected in the Office action mailed August 6, 2008. No claims are amended, but new claims 56-70 are added by this response. Claims 22, 37, 49, and 56 are independent claims. Claims 23-36, 38-48, 50-55, and 57-70 depend, respectively, from claims 22, 37, 49, and 56. Applicants respectfully request reconsideration of pending claims 22-55, and consideration of new claims 56-70, for at least the reasons set forth during prior prosecution, and for the reasons set forth below.

Applicants respectfully note again that although new claims 56-70 are added, no claims in the Application are amended by this response. Applicants respectfully submit that new claims 56-70 recite limitations similar in many ways to those of claims 22-55, and do not add new matter. Therefore, this response does not raise new issues that would necessitate a new search.

Claim Rejections

Claims 22-55 were rejected under 35 U.S.C. §103(a) as being unpatentable over Meyerson et al. (US 5,579,487, hereinafter “Meyerson”) in view of Morris et al. (US 4,884,132, hereinafter “Morris”), in further view of Gans et al. (US 5,610,617, hereinafter “Gans”). Applicants respectfully traverse the rejection.

Applicants respectfully submit that the Office action has failed to establish a *prima facie* case of obviousness, in accordance with M.P.E.P. §2142. According to M.P.E.P. §2142, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” M.P.E.P. §2142 further states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” As recognized in M.P.E.P. §2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” In

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addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

I. Applicants' Prior Arguments Over Meyerson And Morris Are Not Rendered Moot By Gans

As an initial matter, the Applicants respectfully note that the Office has failed to respond to Applicants' arguments regarding the Meyerson and Morris references filed May 16, 2008 in response to the Office action mailed December 19, 2007. Instead, the instant Office action simply states, at page 7:

Applicant's arguments with respect to claims 22 - 55 have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendments to the claims.

Applicants respectfully submit that the arguments set forth in the instant Office action are, for the most part, identical to those set forth in the Office action of December 19, 2007. To illustrate, Applicants have reproduced below the rejection of independent claims 22, 37, and 49 as set forth in the instant Office action, with the differences from the rejection of the December 19, 2007 Office action shown underlined:

(1) with regard to claims 22, 37 and 49:

Meyerson et al. discloses a system and method, comprising: an imaging device (CCD, 160 on Fig. 6; column 9 line 27) for capturing an image; processing circuitry (CPU 142 on Fig. 6 and circuitry 10, 16, 22, 50 on Fig. 1) for processing the image; a wireless communication interface (RF MOD, 30 on Fig. 1; column 5, lines 58 - 61); a display device (display, 50 on Fig. 1; column 6, lines 34 - 35) for providing feedback to a user;

Meyerson et al. does not expressly disclose using the wireless communication interface for transmitting image; and a path used by the device to wirelessly communicate data is

automatically selected based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data.

Morris et al . teaches an image being processed and transmitted over a cellular network (column 1, lines 35 -- 39); and selecting a path automatically to be used by the device to wirelessly communicate data based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data (column 1, lines 35 - 68, processed image data and/or speech data are transmitted wirelessly).

It would have been desirable to transmit image data over a wireless network and selecting a path automatically to be used by the device to wirelessly communicate data based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data, because it would improve the productivity of the system by having the processed image and/or speech data available to user at a remote location. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system of Meyerson et al. with the teaching of Morris et al.

Meyerson et al. does not disclose the path is selected from a plurality of communication paths.

Gans et al. teaches selecting a path from a plurality of communication paths (e.g. see column 5, lines 40 - 43). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Meyerson et al. to determine and select the optimum transmission path to transmit data as taught by Gans et al. in order to optimize the transmission quality of the data.

As can immediately be seen from the above, the only difference in the rejection of claims 22, 37 and 49 in the instant Office action from the immediately prior rejection of these claims (set forth in the Office action of December 19, 2007) is reliance on Gans for support in rejecting a small portion of text that was added by the Applicants solely to further clarify the language of the claims in regard to selecting a path.

M.P.E.P. §707.07(f) states, in part:

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In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

Applicants respectfully submit that the Office has failed to even address, let alone “answer the substance” of Applicants’ arguments regarding the Meyerson and Morris references as set forth in the response filed May 16, 2008. Instead, the Office simply dismisses Applicants’ arguments as moot, **in spite of the fact that the arguments made by the Applicants were directed to rejections that the instant Office action now repeats.** Applicants respectfully submit that the Office has failed to fulfill its obligation under M.P.E.P. §707.07(f), and that it is unfair to the Applicants to needlessly extend prosecution by ignoring Applicants’ arguments over cited references, forcing the Applicants to repeatedly argue what has already been presented but ignored by the Office.

Therefore, Applicants respectfully request that the Office respond to all arguments set forth by the Applicants in the next Office action, should the Examiner fail to allow the claims.

II. The Proposed Combination Of Meyerson, Morris, And Gans Does Not Render Claims 22-55 Unpatentable

With regards to independent claims 22, 37, and 49, Applicants maintain that the Office has failed to establish a *prima facie* case of obviousness, in that the proposed combination of references fails to teach, suggest, or disclose, at least, “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”,

as recited in claims 22, 37, and 49. Applicants respectfully maintain that the Office has failed to consider all of the features of Applicants' claim 22, 37, and 49. Further, the Office has failed to provide a "...clear articulation of the reason(s) why the claimed invention would have been obvious..." and "...some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness...", recognized by M.P.E.P. §2142 as necessary in establishing a *prima facie* case of obviousness. In general, the Office does not explain how the cited teachings are combined to render the subject matter of Applicants' claims, but instead the Office simply points to teachings in the cited references, recites a sometimes generic motivation for the making the combination, and offers a conclusory statement that "...it would have been obvious to one of ordinary skill in the art at the time the invention to [combine teaching X with reference Y]." Applicants respectfully submit that the rejections of the instant Office action do not meet the requirements of M.P.E.P. §2142 some of which are listed above.

Applicants respectfully note that the Office separately admits that Meyerson fails to disclose "...using the wireless communication interface for transmitting image; and a path used by the device to wirelessly communicate data is automatically selected based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data...", and "...the path is selected from a plurality of communications paths...." See *id.* at page 3. In other words, the Office has admitted that Meyerson does not disclose "...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited by Applicants' claims 22, 37, and 49.

The Office, however, then turns to Morris and asserts that Morris teaches "...an image being processed and transmitted over a cellular network (column 1, lines 35-39); and selecting a path automatically to be used by the device to wirelessly communicate data based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data (column 1, lines 35-68, processed image

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data and/or speech data are transmitted wirelessly)." See Office action at page 3. Applicants respectfully disagree with what Morris is alleged to teach.

Applicants respectfully note that the Office cites Morris only at column 1, lines 35-39 and 35-68 in support of the contention that Morris remedies the admitted shortcomings of Meyerson. Applicants first address Morris at column 1, lines 21-43, which includes a portion of Morris cited by the Office (underlined), which states:

The personal security system transmits a picture of an object, such as a criminal suspect, and the identification of a portable transmitter, such as the social security number of the user, to a receiver at a remote location. Time of transmission is recorded. If a crime occurs, the time, picture of the suspect, and identification of the victim are obtained from a recorder at the receiver. A potential victim of a crime points his portable personal security unit at a criminal suspect and presses an activating switch. The unit senses available light on the object and provides a flash if required. At the same time focusing an aperture control is performed and an image of the object is admitted to an image recorder which is a focal plane sensor array. Image data from the focal plane sensor array is processed in an image data processor and the processed image data is fed to a cellular communication transmitter for transmitting to the remote receiving station. An audio pickup at the portable unit is connected to the receiver for transmitting voice communications over the transmitter. By pointing the device at a suspect and pressing a button, a person makes a permanent record of an image.

(underline added)

Applicants respectfully maintain that the portion of Morris shown above simply teaches that a "personal security unit" is used to capture and transmit an image of a suspected criminal, time information, and audio via a cellular communication transmitter to a remote receiving station. The cited portion of Morris does not however, teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of

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data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited by claims 22, 37, and 49. The cited portion of Morris fails to make any mention of, for example, selecting a communication path.

Applicants respectfully submit that the word “select” may be defined as “...to choose (as by fitness or excellence) from a number or group: to pick out....” See Merriam-Webster’s Collegiate Dictionary, Tenth Edition, Merriam-Webster Incorporated, 2002, page 1056. Applicants respectfully submit that Morris does not perform a selection of a path, in that Morris discloses only one path, and merely uses the only path available. The Office has failed to provide any explanation or interpretation of the reference to explain how Morris teaches or suggests selecting from one available path. Automatically using the only path available does not teach or suggest choosing from a number or group, in accordance with the language “automatically selected”, recited in Applicants’ claims 22, 37, and 49. Further, the Office fails to explain how or why Morris teaches selection of a communication path based upon a type of data being communicated.

Instead, Morris teaches that the image data, the time, and audio information are transmitted only via a cellular communication transmitter to a remote receiving station. Morris fails to teach anything with respect to any other paths, and certainly does not teach the availability of “a number or group” of paths from which to choose, in accordance with the language of claims 22, 37, and 49. There is also no disclosure related to the selection of the path used based upon a type of information being communicated, in accordance with the language of claims 22, 37, and 49. Therefore, Applicants respectfully submit that the portion of Morris shown above does not teach or suggest at least these aspects of Applicants’ claims 22, 37, and 49.

Applicants next address the cited portion of Morris at column 1, lines 44-47, which states:

A preferred personal security system has a hand-held unit having a digital image sensor and transmitter for

transmitting a digital image and digital information to a remote location.

Applicants respectfully maintain that the portion of Morris shown above simply teaches that the “personal security unit” preferably is a handheld unit with a digital image sensor and a transmitter for transmitting a digital image to a remote location. Applicants respectfully submit, however, that the cited portion of Morris does not teach or suggest, at least, “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited by claims 22, 37, and 49. Again, the cited portion of Morris fails to say anything about the availability of “a number or group” of paths from which to choose, and therefore does not teach selection of a communication path, let alone path selection based upon a type of data being communicated, in accordance with Applicants’ claims 22, 37, and 49. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least these aspects of Applicants’ claims 22, 37, and 49.

The Applicants’ now turn to address the cited portion of Morris, at column 1, lines 48-50, which states:

The preferred personal security system further has an aperture optically aligned with the sensor for permitting an image to pass through to the sensor.

While the portion of Morris shown above does state that the “personal security system” of Morris preferably has an aperture optically aligned so as to permit an image to pass to a sensor, this portion of Morris, specifically identified by the Office, also fails to teach or suggest, at least, “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or

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both of processed image data and/or speech data...”, as recited by claims 22, 37, and 49. The portion shown above fails to say anything about selection of a communication path, or to mention path selection based upon a type of data being communicated, in accordance with Applicants’ claims 22, 37, and 49. The cited portion of Morris does not teach of “a number or group” of communication paths from which to choose. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least these aspects of Applicants’ claims 22, 37, and 49.

Applicants now address the cited portion of Morris at column 1, lines 51-53, which states:

Preferably, the hand-held unit includes a cellular transmitter and the image sensor is a surface image to digital signal conversion chip.

Applicants respectfully submit that this portion of Morris clearly teaches that Morris has identified cellular communication as the preferred mode, and that the image sensor is preferably “a surface image to digital signal conversion chip.” This cited portion of Morris, specifically identified by the Office, does not, however, make any mention of any other communication paths other than cellular communication, nor does it teach choosing from “a number or group” of communication paths. Accordingly, it necessarily does not teach or suggest, at least, “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited by claims 22, 37, and 49. Again, the cited portion fails to say anything about selection of a communication path, or to discuss path selection based upon a type of data being communicated, in accordance with Applicants’ claims 22, 37, and 49. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least these aspects of Applicants’ claims 22, 37, and 49.

The Applicants’ continue with Morris, at column 1, lines 54-64, which states:

The preferred hand-held unit comprises a start button, a master control function unit connected to the start button, and an electronic power source, an illumination unit, a light sensor unit, a projection lens control unit, an aperture control unit, an image recording unit having a focal plane sensor array, an image processing unit connected to the image recording unit and a cellular communication unit. All of the units are connected to the master control unit and connected to the image processing unit for broadcasting signals from the image processing unit to a distant cellular receiving station.

The portion of Morris shown above merely describes the various elements of the "personal security system" of Morris. Again, this passage from Morris identifies the use of cellular communication for the communication of image signals to a distant receiving station. This portion of Morris, specifically identified by the Office, does not, however, teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited by claims 22, 37, and 49. Once again, the cited portion fails to say anything about the availability of "a number or group" of communication paths or alternatives, about selection of a communication path from such a group, or to even mention path selection based upon a type of data being communicated, in accordance with Applicants' claims 22, 37, and 49. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least these aspects of Applicants' claims 22, 37, and 49.

Finally, Applicants address the portion of Morris at column 1, lines 65-68, which states:

The preferred personal security system further comprises an audio recording unit connected to the cellular communication unit for providing a digital audio signal to the cellular communication unit.

Applicants respectfully submit that the portion of Morris shown above teaches that the “personal security system” of Morris preferably has an audio recording unit connected to provide a digital audio signal to a cellular communication unit. As is clearly stated, Morris again identifies **only** cellular communication for use in communicating information from the “personal security system” to a distant receiving station. This last portion of Morris, however, which was specifically identified by the Office, does not teach or suggest, at least, “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited by claims 22, 37, and 49. The cited portion of Morris fails to say anything about “a number or group” of communication path from which to choose, about selection of a communication path from such alternatives, or to mention path selection based upon a type of data being communicated, in accordance with Applicants’ claims 22, 37, and 49. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least these aspects of Applicants’ claims 22, 37, and 49.

Applicants respectfully maintain that, for at least the reasons set forth above, Morris fails to teach or suggest, at least, Applicants’ feature “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited by claims 22, 37, and 49. As demonstrated above, the Office has previously admitted that Meyerson does not disclose “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data...”, as recited by Applicants’ claims 22, 37, and 49. Applicants respectfully submit that, in view of the admitted and demonstrated shortcomings of Meyerson and Morris, the combination of Meyerson and Morris cannot, by definition, teach or suggest, at least, “...wherein a path used by the device to

wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited by claims 22, 37, and 49.

The instant Office action, in order to overcome the admitted failure of Meyerson to teach “...the path is selected from a plurality of communications paths...” then relies on Gans stating, in part, “...Gans et al. teaches selecting a path from a plurality of communication paths (e.g. see column 5, lines 40 - 43).” See *id.* at page 4. Applicants now review Gans at column 5, lines 40-43, reproduced below (underlined):

As described above, the subject matter of the present disclosure includes the utilization of the signal-to-noise ratio and multipath distortion parameters to determine the optimum transmission path. Thus, the received data transmissions are sampled and processed to determine if the signal-to-noise ratio is above a predetermined threshold and the signal distortion parameter falls below a predetermined threshold. The transmitter/receiver circuitry 58 and controller 60 sweep through and sample the incoming signals from each receiving sector (e.g., each of 16 beams of each of the seven antenna arrays) which is a total of 112 beams. Transmitter/receiver circuitry includes standard commercial equipment. U.S. Pat. No. 4,612,518 to Gans et al. describes a modulator/demodulator scheme which may be used in the transmitter/receiver circuitry, and is incorporated herein by reference. The controller processes the received signals and determines the signal-to-noise ratio and distortion parameters for each beam. Controller 60 then creates a data table which associates the best receiver sector with a particular transmitter sector so that when the receiver and particular transmitter transfer data, the store sectors will be utilized. Controller 60 is a processor controlled unit having memory, stored programs for controlling the transmitter/receiver logic and the switch matrix, and stored programs for determining the optimum transmission path described hereinbelow. An example of a suitable controller is a VXI Bus Controller model HP75000 manufactured by Hewlett Packard.

The portion of Gans shown above teaches the utilization of signal-to-noise ratio and multipath distortion parameters to determine the optimum transmission path, where the received data transmissions are sampled and processed to determine if the signal-to-noise ratio is above a predetermined threshold and the signal distortion parameter falls below a predetermined threshold. Therefore, any selection of transmission path is based on “signal-to-noise ratio” and “multipath distortion parameters”. The cited portion of Gans shown above fails to teach or suggest, however, that the selection of communication path is “...based upon a type of data being communicated...”, in accordance with Applicants’ claims 22, 37, and 49. Further, the Office fails to provide a “...clear articulation of the reason(s) why the claimed invention would have been obvious...”, which M.P.E.P. §2142 recognizes is “[t]he key to supporting any rejection under 35 U.S.C. 103....” The Office does not provide a “clear articulation” of how the cited teachings of Gans, which determine the optimum transmission path based upon “signal-to-noise ratio” and “multipath distortion parameters”, are combined with Meyerson and Morris to render obvious Applicants’ feature “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited by Applicants’ claims 22, 37, and 49. Therefore, Applicants respectfully submit that the Office has failed to show how and why Gans remedies the shortcomings of Meyerson and Morris, demonstrated above.

With regards to dependent claims 28 and 47, the Office action asserts Official Notice and alleges, without any supporting evidence, that “...the use of speech communication in cellular network is well known in the art.” See Office action at page 5. Although a “speech communication in cellular network” may have been well-known in the art, Applicants respectfully challenge the conclusory assertions made in the Office action without any supporting evidence that the elements recited in dependent claims 28 and 47 are well known or obvious in the art, in their respective contexts of independent claims 22 and 37. Applicants respectfully submit that the elements recited

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in claims 28 and 47 are not well known or obvious in their respective contexts. Applicants respectfully submit that, for example, in the context of the elements as recited in independent claims 22 and 37, the elements in dependent claims 28 and 47 are not well known or obvious. M.P.E.P. § 2144.03(E) states that “[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.” Accordingly, in order to maintain the rejection, Applicants respectfully request that the Examiner produce references in support of the Examiner’s contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, then the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2). Applicants respectfully submit that in the absence of such support, the Office has failed to show that Meyerson teaches or suggests at least this aspect of Applicants’ claims 28 and 47. Because the Office only cites Meyerson, the Office has failed to show that the proposed combination renders claims 28 and 47 unpatentable.

With regards to dependent claims 31-33 and 45, the Office action asserts Official Notice and alleges, without any supporting evidence, that “...local area network, packet network, and TCP/IP network are all well known in the art.” See Office action at pages 5-6. Although a “local area network, packet network, and TCP/IP network” may have been well-known in the art, Applicants respectfully challenge the conclusory assertions made in the Office action without any supporting evidence that the elements recited in dependent claims 31-33 and 45 are well known or obvious in the art, in their respective contexts of independent claims 22 and 37. Applicants respectfully submit that the elements recited in claims 31-33 and 45 are not well known or obvious in their respective contexts. Applicants respectfully submit that, for example, in the context of the elements as recited in independent claims 22 and 37, the elements in dependent claims 31-33 and 45 are not well known or obvious. M.P.E.P. § 2144.03(E) states that “[i]t is never appropriate to rely solely on common knowledge in the art without

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evidentiary support in the record as the principal evidence upon which a rejection was based.” Accordingly, in order to maintain the rejection, Applicants respectfully request that the Examiner produce references in support of the Examiner’s contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, then the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2). Applicants respectfully submit that in the absence of such support, the Office has failed to show that Meyerson teaches or suggests at least this aspect of Applicants’ claims 31-33 and 45. Because the Office only cites Meyerson, the Office has failed to show that the proposed combination renders claims 31-33 and 45 unpatentable.

With regard to claim 36, the Office asserts that Meyerson discloses “...that a character recognition process (column 9, line 28, a bar code scanner does character recognition).” See Office action at page 6. Applicants respectfully disagree, and respectfully submit that the Office has failed to show any basis for the conclusory statement that “...a bar code scanner does character recognition.” Applicants respectfully submit that by this statement, the Office is impliedly asserting that it is inherent that a bar code scanner recognizes characters.

According to MPEP §2112, Sec. IV, page 2100-47, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” (emphasis added)

The M.P.E.P. also states, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).” MPEP §2112, Sec. IV, 2100-48 (emphasis in original).

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The Office has failed to show that the “bar code scanner” of Meyerson necessarily performs character recognition. Therefore, Applicants respectfully submit that the Office has failed to show that Meyerson at column 9, line 28 renders Applicants’ claim 36 unpatentable. Because the Office cites only Meyerson, Applicants respectfully submit that the Office has failed to show that the proposed combination of references renders claim 36 unpatentable.

Based at least upon the above, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness with respect to at least claims 22, 28, 31-33, 36, 45, 47, and 49, in accordance with M.P.E.P. §2142, and has therefore failed to show that the proposed combination of Meyerson, Morris, and Gans renders Applicants claims 22, 37, and 49 unpatentable. Therefore, Applicants respectfully submit that the rejection of claims 22, 37, and 49 and their respective dependent claims under 35 U.S.C. §103(a), cannot be maintained.

Therefore, for at least the reasons set forth above, Applicants believe that claims 22, 28, 31-33, 36, 45, 47, and 49 are allowable. Applicants respectfully submit that claims 23-36, 38-48, and 50-55 depend, respectively, from allowable independent claims 22, 37, and 49. Because claims 23-36, 38-48, and 50-55 depend from claims 22, 37, and 49, Applicants respectfully submit that claims 23-36, 38-48, and 50-55 are also allowable, for at least the same reasons. In addition, Applicants respectfully submit that claims 28, 31-33, 36, 45, and 47 are independently allowable. Therefore, Applicants respectfully request that the rejection of claims 22-55 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Newly Added Claims

Applicants have added new claims 56-70, which are similar in many ways to pending claims 22-55. New claim 56 is an independent claim from which claims 57-70 depend. Claims 56-70 recite limitations similar in many ways to claims 22-55, and are allowable for at least the same reasons. Applicants respectfully submit that new claims 56-70 do not add new matter.

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Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim). An early Office Action on the merits and allowance of claims 22-70 is respectfully requested.

Applicants respectfully submit that the claims of the present application should be in condition for allowance for at least the reasons discussed above. Applicants respectfully request that Examiner contact the undersigned at the number shown below, should the Examiner have any questions or if Applicants can be of any assistance.

The Commissioner is hereby authorized to charge any fees required by this submission, or to refund any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: November 5, 2008 By /Kevin E. Borg/
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